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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/629,547	04/09/96	TAKAHASHI T	ATS-032-CON/

PM82/0213

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EXAMINER	
LUONG, V	
ART UNIT	**PAPER NUMBER**
3682	45

DATE MAILED: 02/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/629,547	Takahashi et al.
Examiner	**Group Art Unit**
Vinh Luong	3682

☒ Responsive to communication(s) filed on *10/3/00* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *69-100* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *69-100* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on *4/9/96* is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on *7/23/97* is ☒approved ☐disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☒ received in Application No. (Series Code/Serial Number) *07/485,659* .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Vinh T. Luong
Primary Examiner

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The request filed on October 3, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/629,547 which is a Reissue Application of US Patent No. 5,465,635 (Pat.'635) is acceptable and a CPA has been established. An action on the CPA follows.

2. The Amendment filed on October 3, 2000 (Paper No. 42) has been entered.

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on May 23, 1997 and July 23, 1997 have been approved by the examiner.

4. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. The drawing correction must comply with 37 C.F.R. 1.121(b)(3), e.g., any change to the patent drawings (Figs. 1 and 3) must be by way of a new sheet of drawings with the amended figures identified as "amended."

5. The drawings are objected to because each part of the invention such as the first clearance and the first free space in claim 69; the first free space in claim 72 and the second free space in claim 73 should be designated by a referential numeral or character. Correction is required.

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features such as the axial movement of the flywheel body within the first clearance and the first free space in claim 69; the first free space in claim 72 and the second free space in claim 73 must be shown or the features canceled from the claims. No new matter should be entered.

Figs. 1 and 3 of Pat.'635 show that the flywheel body 5 is *not* axially movable within the first clearance, the first free space and the second free space. Assuming *arguendo* that the flywheel body 5 is axially movable within the first clearance, the first free space and the second free space, the alternate positions of the flywheel body should be shown in accordance with 37 C.F.R. 1.84(h)(4).

7. The amendment filed October 30, 2000 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the added materials: (1) "a first free space is provided after second section 5d *for allowing axial movement of the flywheel body*"; and (2) "a first clearance or second free space is provided between inner surface 5f and the elastic plate 2 *for allowing axial movement of the flywheel body*" is new matter.

The original Figs. 1 and 3 of Pat.'635 show that the flywheel body 5 is rigidly secured to the elastic plate 2 by the bolts 6 (id., line 1 et seq., column 4). Therefore, when the flywheel body 5 is axially moved, the elastic plate 2 is moved therewith. Moreover, Figs. 1 and 3 of Pat.'635 show that the elastic plate 2 is rigidly secured to the reinforcing member 4 by the bolts 3 (id., line 62 et seq., column 3). Therefore, when the elastic plate 2 is moved, the reinforcing member 4 is also moved therewith. Consequently, the flywheel body 5, elastic plate 2 and reinforcing member 4 are moved together in unison. Therefore, the first free space which is provided after second section 5d is unchanged, i.e., the flywheel body 5 is not axially moved into the first free space. Similarly, since the flywheel body 5, elastic plate 2 and reinforcing member 4 are moved together in unison, the first

clearance or second free space which is provided between inner surface 5f and the elastic plate 2 is also unchanged, the flywheel body 5 is not axially moved into the second free space.

In summary, since the flywheel body 5 is not axially moved into the first free space and the second free space, the added limitation that first and second free spaces allow the axial movement of the flywheel body 5 is unsupported by the original record.

Applicant is required to cancel the new matter in the reply to this Office action.

8. Claims 69-100 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

First, the claim language "said first portions of said flywheel body and said elastic plate defining a first clearance and said flywheel body having a first free space on a side opposite of the first clearance *for allowing said first portion of said flywheel body to move axially within the first clearance and the free space*" in "wherein" clause of new claim 69 is unsupported by the prior patent.

As explained above, the flywheel body 5, elastic plate 2 and reinforcing member 4 are moved together in unison, the first clearance or the first free space is unchanged, thus, the flywheel body 5 is not axially moved into the first clearance and the free space. Therefore, the new claimed statement that first clearance and the free space allow the axial movement of the flywheel body 5 within the first clearance and the free space is new matter.

Second, similarly, the claim language "said flywheel body having a first free space on a side opposite of the flywheel facing the elastic plate *for allowing said first portion of said flywheel body*

to move axially within the free space" in "wherein" clause of new claim 72 is unsupported by the prior patent.

As explained above, the flywheel body 5, elastic plate 2 and reinforcing member 4 are moved together in unison, the first free space is unchanged, thus, the flywheel body 5 is not axially moved into the first free space. Therefore, the added limitation that the first free space allows the axial movement of the flywheel body 5 within the free space is new matter.

Third, the "wherein" clause in new claim 70 calls for the axial displacement of the engaging surface is no more than 1mm." However, line 8 et seq. of column 7 of Pat.'635 merely provides support for the range of "no more than 0.1mm. Since the new range of no more than 1mm is plainly outside the disclosed range of 0.1mm, thus, claim 70 introduces new matter. See *In re Myers*, 161 U.S.P.Q. 668(CCPA 1969).

9. Claims 69-100 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc.* v. *Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp.* v. *United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope

surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

It is well settled that a reissue application is not permitted to "recapture" claimed subject matter *deliberately* canceled in the original application. *In re Clement*, 45 U.S.P.Q. 1161 (CAFC 1997). See M.P.E.P. 1412.02. Note also that in *Hester v. Stein, Inc.*, 46 U.S.P.Q.2d 1641 (CAFC 1998), the Court held that the recapture rule can be triggered by argument alone. Applicant *cannot* acquire, through reissue, claims that are the *same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection.*

Regarding claims 69 and 72, lines 8-17 of claims 69 and 72 recite the limitations in claim 16 of grand parent application Serial No. 07/485,659. However, claim 16 of SN'659 had been rejected by the examiner and affirmed by the Board of Appeal of the Office on January 5, 1994. On the other hand, the scope of the rest of claims 69 and 72 of this application is narrower in another aspect unrelated to the prior art rejection based on Numata et al. (Japanese Patent Publication No. 57-058542). Since claim 16 of SN'659 had been rejected and canceled in SN'659, applicant cannot recapture it by adding a limitation unrelated to the rejection based on Numata et al. as done in claims 69 and 72.

Regarding new claims 76, 79 and 88, note that claims 76, 79 and 88 recite the limitation "no more than 0.1mm" in claim 18 of SN'659. However, claim 18 of SN'659 had been rejected by the examiner and affirmed by the Board of Appeal of the Office on January 5, 1994. On the other hand, the scope of the rest of these claims in this application is narrower in another aspect unrelated to the

prior art rejection based on Numata et al. (Japanese Patent Publication No. 57-058542). Since claim 18 of SN'659 had been rejected and canceled in SN'659, applicant cannot recapture it by adding a limitation unrelated to the rejection based on Numata et al. as set forth above.

New claims 70, 71, 73-75, 77, 78, 80-87 and 89-100 are dependent upon either claim 69 or 72. Therefore, these new claims add further limitations to claim 69 or 72, i.e., these new claims add further limitations unrelated to the rejection in SN'659. Consequently, these new claims are also rejected under the recapture rule for adding further limitations unrelated to the rejection based on Numata et al. in SN'659.

10. Applicant's arguments filed October 3, 2000 (Paper No. 42) have been fully considered but they are not persuasive.

Objection to the Specification

To overcome the objection, applicant introduced new matter as explained above. It is well settled that the defect in the specification cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the application was originally filed. *In re Hay*, 189 U.S.P.Q. 790 (CCPA 1976) and M.P.E.P. 608.01(h).

35 USC 112, Second Paragraph

The instant rejection has been withdrawn in view of applicant's new claims.

35 USC 251

Applicant contended that the new method claims are no longer subject to recapture.

First, applicant admitted on pages 14 and 15 of Paper No. 42 that applicant's method claims recite the limitations of the product or apparatus claims, *a fortiori*, the method claims are not patentably distinct from the product claims, and should be rejoined. See PTO procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86).

Second, applicant admitted in, e.g., second paragraph on page 17 of Paper No. 42 that claims 69 and 72 recall the limitations of canceled claim 16 of SN'659 which had been rejected by the examiner and affirmed by the Board of Appeal of the Office on January 5, 1994. Applicant further admitted in, e.g., the last paragraph on page 17 of Paper No. 42 that new claims 69 and 72 add new limitation such as the axial movement of the flywheel body. The instant new limitation is narrower in another aspect unrelated to the prior art rejection based on Numata et al. (Japanese Patent Publication No. 57-058542). Since claim 16 of SN'659 had been rejected and canceled in SN'659, applicant cannot recapture it by adding said limitation unrelated to the rejection based on Numata. The recapture rule is applied pursuant to *Hester v. Stein, Inc., supra*.

Third, applicant contended that the clearance or opening is not a tangible thing. The examiner does not dispute applicant's contention about the clearance. However, since the claimed clearance in new claims 69 and 72 plainly adds a limitation unrelated to the rejection based on Numata, claims 69 and 72 are rejected under capture rule.

Finally, applicant asserted that applicant's research found no cases that support the position that PTO can reject claims of one statutory category (i.e., method) based on alleged case of recapture of claims of a different statutory (i.e., product). Applicant apparently overlooked the fact

that when the claims of one statutory category are not patentably distinct from the claims of a different statutory such as the instant case, if the product/apparatus is not patentable due to recapture, the method is also not patentable due to recapture, i.e., the recapture rule is applied to both categories in order to maintain uniform patentability standard. See PTO procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), M.P.E.P. 706, 1412.02 and 1412.03.

11. Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 305-7687**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P. 512). The following is an example of the format the certification might take:

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If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 7:30 AM EST to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

February 9, 2001

Vinh T. Luong
Primary Examiner